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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/881,091   | 06/15/2001  | Kiril A. Pandelisev  | PHOENIX SCIENTIFIC  | 7262             |
| 7590 04/02/2004  |             |                      | EXAMINER            |                  |
| James C. Wray<br>Suite 300<br>1493 Chain Bridge Road<br>McLean, VA 22101 |             |                      | HOFFMANN, JOHN M    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1731                |                  |

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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| APPLICATION NO./<br>CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR /<br>PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. AS |
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40330

DATE MAILED:

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**Commissioner for Patents****Response to Arguments**

On 23 March 2004 Applicant submitted a request to reconsider the holding of a the amendment of 23 February 2004 was non-responsive.

It is argued that the Office is requiring that the claims must claim the creation of particles from within the substrate. This is not accurate. Examiner apologizes for anything which may have conveyed such. The Office's requirement is simply that the claims must be of a scope which encompasses the elected invention. For example, generic claims do not have the limitations of species claims. Examiner is not requiring applicant to limit the claims to a specific embodiment – Applicant is free to present claims that are generic to all of the species – including both elected and non-elected species. For example original claim 65 did not recite creating particles within the tube, but it was generic to the elected species and thus was examined. However, the most recent amendment changed claim 65 so it was no longer generic to the elected species. Rather it was amended to be completely outside the scope of the elected species.

It is also argued that examiner “created some species that is not within the...specification and has mislead by some arbitrary initials.” The first page of the specification clearly indicates that Applicant is familiar with the conventional designation “MCVD”; moreover, Applicant sets forth that MCVD is “part of this invention” (line 12). Examiner does not understand what is “arbitrary” about it. Applicant clearly indicated that Applicant was familiar with MCVD and that the claims would cover MCVD. Anyone reading the present application would realize without any doubt that Applicant intended to encompass MCVD methods. It was not the Examiner’s use of the initials “MCVD” which caused anyone to be misled.

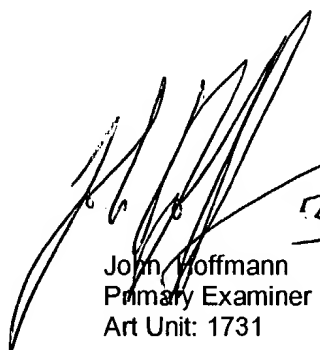
Further arguments point to the specification and drawings – and how they are only directed to a non-elected invention. And, ostensibly, that only the species of the drawings/application should be examined. Examiner disagrees because 1) Applicant refers to MCVD as being part of the invention, 2) Applicant elected the MCVD species, 3) there were 150 claims that were filed, and they were directed to innumerable different concepts – many of which were mutually exclusive of each other. And examiner could not see anything in any of the claims which was conventional or a routine modification. One could not reasonably expect Examiner to determine that Applicant actually did not intend to claim MCVD.

Applicant argues that figure 5 is MCVD. There is no basis for this assertion. The term has a history of at least 28 years – going back to at least US Patent 3966446. It appears that Applicant has been using some other definition for MCVD. There is a presumption that applicants are familiar with terms of art. Examiner searched for “MCVD” on the Office’s EAST database and came up with 1098 hits. It is clearly a well-recognized term of art. Applicants are generally not permitted to redefine well-accepted terms of art. Moreover, if an applicant intends to wishes to define anything, the specification must clearly set forth an explicit definition. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F3d 985, 989 (Fed. Cir.1999). Applicant does not define what Applicant means by MCVD.

It is still further argued that the claims are directed to the broadest methods. This does not appear to be accurate. There is no

explanation as to why Applicant concludes this. If any claims actually encompass the MCVD method, Applicant should point out specifically why this is so. If this is the case, it would seem that Examiner and Applicant interpret the claims differently – which would then raise the question whether the claims are definite.

Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).



3-31-04  
John Hoffmann  
Primary Examiner  
Art Unit: 1731